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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,368

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Yukio Miyaki

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EXAMINER

WANG, EUGENIA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,368	Applicant(s) MIYAKI ET AL.	
	Examiner Eugenia Wang	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the amendment received October 29, 2007:
 - a. Claim 5 has been cancelled as per Applicant's request. Claims 1-4 are pending.
 - b. The previous objection to the drawings has been withdrawn in light of the argument.
 - c. The objection to the specification has been withdrawn in light of the amendment.
 - d. The claim objection is withdrawn in light of the amendment.
 - e. The 112 rejection to claim 1 (and subsequently 2 and 3) is withdrawn in light of the amendment. The 112 rejection to claim 4 is maintained.
 - f. The core of the rejection is maintained, with any changes as necessitated by the amendment.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elliptical and shape including a straight line and a curved line must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

NOTE: This new drawing objection is made in light of the amendment to claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the group" in line 3. There is insufficient antecedent basis for this limitation in the claim. Changing the definite article "the" to 'a' is suggested.

Response to Arguments

4. Applicant's arguments filed October 29, 2007 have been fully considered but they are not persuasive.

Applicant argues that the correction has been made.

Examiner respectfully disagrees. Claim 4 (line 3) still reads "the group" rather than 'a group'. This group is different than that of claim 1 and thus must be addressed with the indefinite article 'a' instead of "the" as well.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0704921A1 (Fujimoto et al.).

As to claim 1, Fujimoto et al. teaches a cylindrically wound battery, where the electrode material mixture (both positive electrode, cathode, and negative electrode, anode are included) is present on both the inner and outer sides of the current collector (abs). Furthermore, the negative electrode active material is chosen such that the efficiency of lithium intercalation and deintercalation is high (p3, lines 37-39). The compounds used in the negative electrode materials are from groups IIIb, IVb, and Vb of the periodic table (all of which fit the description of metals or metalloids capable of alloying with lithium and compounds therefore) (p3, lines 32-36). (Starting at p3, line 40, many examples of active materials are listed.) As previously stated, the battery of Fujimoto et al. is cylindrical (p2, lines 48-49). NOTE: A cylinder inherently has a circular

cross section (sectional surface shape), as is defined by the constraints of a cylindrical volume. A circle is a special type of ellipse; in an ellipse that is a circle, the longest diameter to the shortest diameter is 1:1 (or 1, inclusive, as claimed by the instant application). Furthermore, it is listed that the thickness of electrode material mixture on the inner side of the collector is from 60% to 97%, more preferably 70% to 95%, of the outer collector. The difference in thickness inherently provides a difference in capacity, as the thicker layer contains more active material, and thus has more capacity. In Fujimoto's teaching, the ratio ranges of capacity of the outer active material to the inner active material would be from 1:0.6 to 1:0.97, inclusive, more preferably 1:0.7 to 1:0.95, inclusive. A portion of Fujimoto et al.'s range covers the claimed ratio, and therefore would inherently provide the same claimed ratio difference.

Alternately, it can be said that Fujimoto et al. does not disclose the specific capacity ratio of the outer anode active material to the inner active anode material that is from 1:0.6 to 1:0.8, inclusive. However, it has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference in the range or value is minor. Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

Claims that differ from the prior art only by slightly different (non-overlapping) ranges are prima facie obvious without a showing that the claimed range achieves unexpected results relative to the prior art. (In re Woodruff, 16 USPQ2d 1935,1937 (Fed. Cir. 1990)). Selection of optimum ranges within the prior art's general condition is obvious. (In re Aller, 105 USPQ 233(CCPA 1955)).

As to claim 2, Fujimoto et al.'s most specific formula of the active material used is $\text{SnSi}_t\text{P}_u\text{AL}_v\text{O}_s$ represented by formula (V) (p4, line 50). Furthermore, the use of tin monoxide and silicon dioxide is exemplified in the synthesis examples 1-5 (p7-8),

As to claim 3, the outer anode active material layer and the inner anode active material layer are inherently alloyed with the current collector, because the tin used in the exemplified in the anode active material is able to be alloyed with the exemplified anode current collector (copper, as is used in example 1 on p12, lines 22-26).

As to claim 4, in example 1, a negative electrode material is prepared via dispersion and applied to the current collector (p12, lines 22-26). This application is a liquid-phase deposition.

Response to Arguments

6. Applicant's arguments filed October 29, 2007 have been fully considered but they are not persuasive.

Applicant argues that since Fujimoto et al. teaches a cylindrical battery, the spirally wound body would not have either (a) an elliptical shape or (2) a shape including a straight line and a curved line, wherein the ratio of the longest diameter to the shortest diameter of either shape is 1 to 3, inclusive.

Examiner respectfully disagrees. The position is that a cylindrical shaped battery has a sectional surface that is circular in shape. A circle is a special type of ellipse, wherein the ratio of the longest diameter to the shortest diameter is 1.

Additionally, Examiner would also like to point out Applicant's own specification shows that one of ordinary skill in the art would have known to change the shape of a battery, as it notes a cylindrical battery with a circular center shape, and elliptical shape, or a shape including a straight line and a curved line (see the last paragraph of page 6, and the remainder of that paragraph on page 7). Furthermore, there are no drawings that show an elliptical shaped wound electrode assembly or one with a straight line and a curved line shape. Figs. 1 and 2 embody a cylindrical battery. Because of these reasons, it is Examiner's position that there is no criticality to the shape of the battery.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugenia Wang whose telephone number is 571-272-4942. The examiner can normally be reached on 7 - 4:30 Mon. - Thurs., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EW


GREGG CANTELMO
PRIMARY EXAMINER